

REMARKS/ARGUMENTS

Claims 1-12, 14-36 and 38-60 were rejected.

The Office Action has been carefully considered. Claims 1-12, 14-36 and 38-60 are pending. Claims 13 and 37 are canceled. The Office Action rejected Claims 1-12, 14-36 and 38-60 in the following manner.

1. Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,185,306 to Mages et al. (hereinafter “*Mages*”) in view of U.S. Patent No. 6,510,553 to Hazra (hereinafter “*Hazra*”).
2. Claims 2-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Mages* in view of *Hazra*, and further in view of U.S. Patent No. 6,373,831 to Secord et al. (hereinafter “*Secord*”).
3. Claims 9-12, 14-36, and 38-60 were rejected “under the same criteria as above.”

Claims 1-2, 4, 6-12, 15-16, 18-23, 25-27, 30-31, 33-35, 39, 42-52, 54, 56, and 58-60 are currently amended to clarify the intended scope of the claims. In particular, in an attempt to more clearly state the existing subject matter, Applicants have re-phrased the claims to refer to first and second data files and to explicitly define the elements that comprise the first and second data files. Applicants believe that these amendments merely clarify the existing subject matter of the claims.

Applicants have also deleted unwanted elements specifying in substance that the second file portions do not refer to the locations of the first file portions. These amendments actually broaden the claims and should not give rise to prosecution history estoppel.

35 U.S.C. § 103 Rejections

To establish a *prima facie* case of obviousness, Office personnel have the burden to meet three basic criteria. First, Office personnel must show that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art, not based on applicant’s disclosure. Second, Office personnel must show that the teachings in the prior art have a reasonable expectation of success. Finally, Office personnel must show that the combined prior art references teach or suggest every element of the claim. *See* MPEP § 2142.

Mages in view of Hazra does not teach or suggest every element of Claim 1.

Claim 1 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Mages* in view of *Hazra*. However, Applicants respectfully submit that neither *Mages* nor *Hazra*, alone or in combination, teaches or suggests every element of amended Claim 1. Claim 1 reads as follows:

A method of assembling a media file for playing in an electronic device, comprising:

receiving a first data file with the electronic device from a first computing device via a first communication channel as a result of commands initiated from a media client of the electronic device, wherein **the first data file comprises the media file lacking at least one portion from each of a plurality of locations within the media file** and is unusable as a media file;

receiving a second data file with the electronic device from a second computing device via a second communication channel as a result of commands initiated from the media client, wherein **the second data file comprises said at least one portion lacking from each of said plurality of locations within the media file** and is unusable as a media file ; and

creating with the media client the media file in the electronic device from the first data file and the second data file .

***Mages* in view of *Hazra* does not teach or suggest that the first data file comprises the media file lacking at least one portion from each of a plurality of locations within the media file.**

By current amendment, Claim 1 clarifies the claimed subject matter, reciting “the first data file comprises the media file lacking at least one portion from each of a plurality of locations within the media file....” *See, e.g.*, Figs 2a-c. By contrast, *Mages* teaches merely that content or a “HyperCD” may be “crippled” by “achieved by removing critical information such as the video-audio header, whereupon such video/ audio data is rendered unreadable by the end-user’s computer.” Col. 6 lines 39-43. Thus, *Mages* cripples content in a manner that differs starkly from that claimed in Claim 1, in which portions from a plurality of locations throughout the media file are missing in a first data file.

Hazra discloses nothing related to crippled media, teaching merely that an entire media file “may be authored as multiple independent streams.” Col. 8 line 54-Col. 9 line 15.

None of the cited references, alone or in combination, teach or even suggest a first data file that comprises the media file lacking at least one portion from each of a plurality of

locations within the media file. Accordingly, Applicants respectfully submit that amended Claim 1 is in condition for allowance.

***Mages* in view of *Hazra* does not teach or suggest a second data file that comprises the at least one portion lacking from each of said plurality of locations within the media file.**

In the Office Action at 2, *Hazra*'s "multiple layers of a single data stream" were said to be the "equivalent of the portions in the instant application." Applicants have amended Claim 1 to clarify that the claimed first and second data files are not at all equivalent to *Hazra*'s layered media. Indeed, as noted in the Office Action, each layer as taught by *Hazra* "may be received and decoded without reference to the others." *Hazra* further teaches that "The client system may switch between the different available streams under conditions of changing bandwidth (for example, the client system may switch subscription from a high data rate stream to a lower data rate stream)."

By contrast, Claim 1 specifies that a "second data file comprises said at least one portion lacking from each of said plurality of locations within the media file...." Thus, Claim 1's second data file is unusable as a media file, while *Hazra*'s layers differ in that they are independently renderable. Moreover, Claim 1's second data file comprises at least one portion lacking from each of a plurality of locations within the media file. By contrast, *Hazra*'s layers are each independent encoding that may be switched between as conditions change.

At least as described above, Claim 1 recites limitations that are patentably distinct from what is taught or suggested by *Mages* in view of *Hazra*. Accordingly, Applicants respectfully submit that Claim 1 is not obvious considering *Mages* in view of *Hazra*. Independent Claims 9, 15, 26, 32, 39, 51, and 53 are also allowable through similar reasoning.

Claims 2-8 are allowable by dependency and because the Office Action has failed to state a prima facie case of obviousness.

Claims 2-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Mages* in view of *Hazra*, and further in view of *Secord*. However, Claims 2-8 are allowable at least by dependency because *Secord* does not, by way of disclosure or suggestion, remedy the deficiencies in *Mages* and *Hazra* that are discussed above. On the contrary, *Secord* describes

merely a Code Division Multiple Access transmission system, such as is commonly used with cell phones.

There are also additional reasons why Claims 2-8 are not obvious considering *Mages*, *Hazra*, and *Secord*. For example, the Office Action has not asserted that the prior art of record teaches or suggests “using the media client to make the memory in which a least a portion of the media file is stored available for re-use once at least a portion of the media file has been played,” as claimed in Claim 3. Applicants are unable to discern where, if at all, *Mages*, *Hazra*, and *Secord* teach or suggest this element. Thus, the Office Action has failed to state a *prima facie* case that Claim 3 is obvious. Accordingly, Claim 3, as well as Claims 2 and 4-8 are in condition for allowance.

Claims 9-12, 14-36, and 38-60 are allowable by similar reasoning.

Applicants respectfully assert that all remaining claims are patentably distinguishable from the cited documents on at least the same and/or a similar basis as Claims 1-8. Therefore, it is respectfully requested that the Examiner withdraw these rejection and allow the pending claims to proceed to issuance.

CONCLUSION

For at least the reasons above, Applicant respectfully submits that claims 1-12, 14-36, and 38-60 are allowable and requests that the Examiner permit these claims to proceed to issuance. Although additional arguments are believed to exist for distinguishing the cited documents, including those advanced in Applicant's paper filed April 25, 2008, the foregoing arguments and amendments are believed sufficient to address the Examiner's rejections. Likewise, failure of the Applicant to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. Instead, it is believed that the Examiner's positions are rendered moot by the foregoing arguments and amendments. Therefore, it is believed not necessary to respond to every position taken by the Examiner with which Applicants do not agree.

The Examiner is respectfully requested to contact the undersigned at the telephone number below if there are any remaining questions regarding this Application.

We believe the appropriate fees accompany this transmission. If, however, insufficient fee payment or fee overpayment occurs, the amount may be withdrawn or deposited from/to AXIOS Law Group's deposit account. The deposit account number is 50-4051.

Respectfully submitted,
AXIOS LAW GROUP

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